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09/855,196	05/14/2001	Christopher Peter Olson	KCC-14,944	8184

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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/855,196
Filing Date: May 14, 2001
Appellant(s): OLSON ET AL.

Melanie Rauch
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/30/07 appealing from the Office action mailed 11/3/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,680,653	Mathis et al.	10-1997
6,478,786	Glaug et al.	11-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-37 rejected under 35 U.S.C. 103(a) as being unpatentable over Mathis et al. USPN 5680653 in view of Glaug et al. USPN 6478786.

As to claims 1-4, 15-19, and 27, Mathis discloses an elastic composite to be used in the vicinity of waist and leg openings of an absorbent article (Abstract, col. 4, lines 7-20, and Figures 1, 2, and 4-7). Applicant has defined "apparent elastic band" on page 7, line 12 through page 8, line 6 of the specification, which includes a stretchable material overlaying all or part of a waist region or leg cuff/hem area of a garment that may be attached to underlying elastic materials that provide elastic retraction. The elastic composite of Mathis comprises a stretchable material adhered to an elastomeric material in the region of a waist or leg/cuff area of an absorbent article. The claims are directed to a targeted elastic material based on the definition given on page 8 of the specification. However, this definition is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re

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Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

MPEP 2113. Based on applicant's definition, Mathis meets the limitations of an "apparent elastic band".

Mathis does not disclose a color pigment applied to a substrate. Glaug discloses a color in the waist area of the elastic fibers for the benefit of providing a distinctively colored area to facilitate the correct orientation of the undergarment. One having ordinary skill in the art at the time the invention was made would have been motivated to modify the invention of Mathis, particularly in a footwear application (Mathis col. 3, lines 20-23) with a colored area to assist the user in proper orientation of the garment as taught in Glaug.

As to claims 5, 20, and 21, Mathis discloses a targeted elastic material 24 having selected areas or zones of elasticity (col. 6, lines 24-31), which creates low tension (inelastic zones) and high tension (elastic zones).

As to claim 6 and 22, the layer 22 overlays the layer 24.

As to claims 7-12, 23, and 24, see col. 5, lines 24-42.

As to claim 13 and 25, see the discussion of claims 1 and 5, *supra*.

As to claim 14 and 26, see the discussion of claims 1 and 6, *supra*.

As to claims 28-37, the limitations regarding the type of disposable garment are directed to an intended use of the article. "Intended use must result in a structural

difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations. Mathis discloses various applications for the elastic laminate (col. 3, lines 21-26).

(10) Response to Argument

Applicant's arguments filed 4/30/07 have been fully considered but they are not persuasive. Applicant argues the terms "targeted elastic regions" and "targeted elastic material("TEM")" as defined on page 8 of the specification is not directed to a process of manufacture. Applicant argues the TEM is a material made by a process that results in a significantly different product than an underlying material with an elastic band attached (externally). However, the definition of "targeted elastic material (TEM) on which applicant relies is directed to a process of manufacture in the sense that "TEM's include only materials or laminates which are made in a single manufacturing process" and "TEM's do not include materials having elasticized regions achieved through separate manufacture of an elastic band and subsequent connection of the elastic band to the underlying material. This definition is directed to the process in which the elastic material is made. Determination of patentability is based on the product itself rather than the process of making. Applicant argues the "targeted elastic material" includes only materials, which do not require an added external elastic band or layer in the

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targeted elastic region. The targeted elastic material of the present application has not been defined in the original specification as internal or external to the material. The targeted elastic regions are defined in the specification as isolated, narrow bands or regions in a single composite material or layer, which have greater elastic tension than adjacent surrounding regions. The TEM is defined as a single elastic material or laminate having targeted elastic regions. Therefore, the TEM is a single elastic material or laminate in an isolated narrow band or region having greater elastic tension than adjacent surrounding regions. Because this single elastic material or laminate is limited to a band or region, it forms an elastic band, which is disclosed by the prior art.

Applicant argues Glaug discloses only distinctively colored discrete elastic fibers and fails to disclose or suggest an "apparent" elastic band in which a visible perception of a discrete elastic band is created where there is no actual band. Applicant further argues the term "elastic band" is defined in the application as a discrete elongated long, relatively narrow element that is separately manufactured and then attached to an underlying material. Mathis teaches a stretchable material attached to an underlying material; therefore, Mathis provides an apparent elastic band as defined by applicant. The Examiner relies on Glaug for a teaching of a color applied to a zone in a targeted elastic material. Applicant argues that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Glaug is not relied on to teach an apparent elastic band. The motivation to combine the references is found in Glaug, which teaches colored areas to facilitate the correct orientation of the article (Glaug col. 5, lines 55-65).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.



For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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